

Claim 40: Pending (amended for the first time in this Amendment). This claim was amended to include the limitation "said respective valve devices cooperating to form a fluid separator having a movable pressure boundary that enables said normal source of pressurized hydraulic brake fluid to selectively act upon said respective vehicle brakes via a portion of said backup source." Support for these amendments can be found in at least Figs. 1 and 10 and in Cols. 5 through 12 of the Specification as filed.

Claim 41: Pending (added in this Amendment). Support for these amendments can be found in at least Figs. 1 and 10 and in Cols. 5 through 12 of the Specification as filed.

Claim 42: Pending (added in this Amendment). Claim 42 includes the limitation "a structure for receiving said first fluid and said second fluid for operation of the vehicle and having a movable pressure boundary for preventing intermixing of said first fluid and said second fluid while said vehicle brake is operating." Support for these amendments can be found in at least Figs. 1 and 10 and in Cols. 5 through 12 of the Specification as filed.

Claims 43 through 46: Pending (added in this Amendment). Each of these claims depend, directly or indirectly from new Claim 42. Support for these amendments can be found in at least Figs. 1 and 10 and in Cols. 5 through 12 of the Specification as filed.

REMARKS

This Amendment is filed responsive to the Office Action dated February 4, 2005. Reconsideration of the application, as amended, is respectfully requested.

PARAGRAPH 1

The Examiner has asserted that the person signing the submission establishing ownership interest, Mariann McNally, has failed to state his/her capacity to sign for

the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee.

Applicants respectfully disagree. Ms. McNally indicated her title to be "Assistant Secretary". She is a corporate officer of the Assignee corporation, with the apparent authority to sign, as denoted by her title. According to the MPEP § 324 (II) (A):

The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. 37 CFR 3.73(b)(2)(ii). An officer (chief executive officer, president, vice-president, **secretary**, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. **Modifications of these basic titles are acceptable, such as** vice-president for sales, executive vice-president, **assistant** treasurer, vice-chairman of the board of directors. (**emphasis added**)

Since the MPEP clearly indicates that the corporate title "Secretary" is presumed to have authority to sign on behalf of the organization, and that a modification of this basic title would be acceptable, and the MPEP even includes the modifier "assistant" among the modifiers specifically approved as acceptable, it is clear that, as Assistant Secretary, Ms. McNally has the apparent authority to sign on behalf of her organization, and she is not required to further establish her authority.

Nevertheless, Applicants have *previously supplied* a Statement Under 37 C.F.R. § 3.73(b), signed by Ms. McNally, which indicates (above her signature) that she is authorized to act on behalf of the assignee (see accompanying copy). Accordingly, the Examiner is requested to withdraw his requirement for another submission establishing ownership interest in the patent.

PARAGRAPH 2

The Examiner has noted that the original patent must be received by the United States Patent and Trademark Office before the reissue application can be allowed.

Applicants request that the Examiner contact the undersigned Attorney (or another attorney in the same law firm - telephone number 419-255-5900) by telephone and/or in writing to advise of the need to send in the original patent once all other issues in the application have been resolved, and the reissue application has been determined to be in condition for allowance *except for* the submission of the original patent.

PARAGRAPH 3

The Examiner rejected Claims 21 through 25, and 36 through 40 under 35 U.S.C. § 251 as being improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

With respect to Claims 23 through 25 these claims now depend directly or indirectly from Claim 18, which was a claim in the originally granted patent. Therefore, these claims cannot be broadened claimed subject matter.

Applicants note that in the paragraph spanning pages 6 to 7 of the Office Action, the Examiner references arguments made with respect to "independent claim 8" and suggests limitations that should attach to new claims in the reissue application. Applicants respectfully traverse this suggestion, noting that Claim 8 in the original application was a DEPENDENT claim, not an independent claim. Thus, elimination of the limitations added to Claim 8 is not recapture, since Claim 1, from which Claim 8 depended, is by definition broader than Claim 8 as originally presented. Similarly, the Examiner refers to arguments presented with respect to Claim 3. Again, Claim 3 was a dependent claim, and the omission of limitations added to Claim 3 from new claims in the Reissue Application is not recapture.

On page 7 of the Office Action, the Examiner states that "because the limitations of the amended claims in the patent, which are germane to the prior art of record as substantiated by applicant's arguments, are not found in at least substantially the same form in any of the independent claims submitted in the reissue application, they remain rejected under the recapture doctrine..." (emphasis added). Respectfully, Applicants do not believe that this is the proper test. The recapture doctrine merely requires that the claims in a broadening reissue application, such as this one, cannot be

as broad or broader than the claims before amendment in the original application (that is, not as broad or broader than the subject matter given up). The recapture doctrine does NOT require that any limitation in a new claim in the reissue application be in substantially the same form as the amended limitation in the original application.

Applicants are allowed to seek a limitation which is broader in scope in an area directed to an Amendment made to overcome art in the original application, as long as Applicants retain, in broadened form, the limitation added. (see MPEP §1402 I.C2(d)). Here the limitation relating to the fluid separator is broader than the limitation added to Claim 1 in the original application ("having a movable pressure boundary"), yet narrower than the limitations relating to the fluid separator existing before the amendment adding the limitation to Claim 1 in the original application (the "canceled claim subject matter in an area relating to the surrender"). Claim 22 as now presented is narrower than Claim 1 as filed in the original application with respect to the area relating to the surrender (the fluid separator) in that Claim 22 now requires at least two fluid separators, each of which is "interposed between each of said first and second wheel brakes of said first vehicle axle and an associated one of the electrically controllable brake valve devices, said first and second wheel brakes being connected to a respective one of said isolation valves associated with said two brake circuits of said master cylinder".

Assuming, for the sake of argument, as the Examiner has asserted, that a "fluid separator and movable pressure boundary" are elements added in response to an art rejection or are "key limitations," a substitute limitation that is related to the "key limitation" may be narrower or broader than the key limitation, as cited in *Attachment B, U.S.P.T.O. Memorandum dated August 4, 2003, entitled "Updated Guidance as to Applying the Recapture Rule to Reissue Applications," and Pannu v. Storz Instruments, Inc. 258 F.3d 1366*. In the Office Action, the above-described "substitute limitation" principle is summarized at page 5, paragraph C. In the accompanying amended and new claims, the "key limitations" or omitted limitation as asserted by the Examiner, have been replaced with a substitute limitation that is related to the subject matter previously surrendered by the Applicant as will be described

herein.

Applicants note that Claim 22 as amended includes the limitation "a respective fluid separator unit being interposed between each of said first and second wheel brakes of said first vehicle axle and an associated one of the electrically controllable brake valve devices, each of said fluid separator units having a movable component and cooperating with one another to form a pressure boundary that enables said normal source to selectively act upon said vehicle brake via a portion of said backup source," which is a substitute limitation for the asserted "key limitation" of a fluid separator and movable pressure boundary. Accordingly, Applicants believe that Claim 22 is proper in scope with respect to the recapture doctrine, and the Examiner is requested to withdraw the rejection thereof under 35 U.S.C. § 251.

Claim 36 as amended includes the limitation "a respective valve arrangement ... having a movable component forming a pressure boundary which enables said normal source of pressurized hydraulic brake fluid to selectively act upon said respective vehicle brakes via a portion of said backup source." Applicants note that this limitation is a substitute limitation for the asserted "key limitation" of a fluid separator and movable pressure boundary as described above in reference to Claim 22. Accordingly, Applicants believe that Claim 36 is proper in scope with respect to the recapture doctrine, and the Examiner is requested to withdraw the rejection thereof under 35 U.S.C. § 251.

Claim 37 as amended includes the limitation "said respective fluid separator units having movable components that cooperate to enable said normal source of pressurized hydraulic brake fluid to selectively act upon said respective vehicle brakes via a portion of said backup source." Applicants note that this limitation is a substitute limitation for the asserted "key limitation" of a fluid separator and movable pressure boundary as described above in reference to Claim 22. Accordingly, Applicants believe that Claim 37 is proper in scope with respect to the recapture doctrine, and the Examiner is requested to withdraw the rejection thereof under 35 U.S.C. § 251.

Claim 38 as amended includes the limitation "each of said isolation valves having a movable component, said isolation valves cooperating with one another to

form a pressure boundary that enables said normal source of pressurized hydraulic brake fluid to selectively act upon said vehicle brake via a portion of said backup source." Applicants note that this limitation is a substitute limitation for the asserted "key limitation" of a fluid separator and movable pressure boundary as described above in reference to Claim 22. Accordingly, Applicants believe that Claim 38 is proper in scope with respect to the recapture doctrine, and the Examiner is requested to withdraw the rejection thereof under 35 U.S.C. § 251.

Claim 40 as amended includes the limitation "said respective valve devices cooperating to form a fluid separator having a movable pressure boundary that enables said normal source of pressurized hydraulic brake fluid to selectively act upon said respective vehicle brakes via a portion of said backup source." Applicants note that this limitation is a substitute limitation for the asserted "key limitation" of a fluid separator and movable pressure boundary as described above in reference to Claim 22. Accordingly, Applicants believe that Claim 40 is proper in scope with respect to the recapture doctrine, and the Examiner is requested to withdraw the rejection thereof under 35 U.S.C. § 251.

New Claim 42 includes the limitation "a structure ...having a movable pressure boundary for preventing intermixing of said first fluid and said second fluid while said vehicle brake is operating." Applicants note that this limitation is a substitute limitation for the asserted "key limitation" of a fluid separator and movable pressure boundary as described above in reference to Claim 22. Accordingly, Applicants believe that Claim 42 is proper in scope with respect to the recapture doctrine, and the Examiner is requested to withdraw the rejection thereof under 35 U.S.C. § 251.

PARAGRAPHS 5 & 6

The Examiner rejected Claim 21 and 23 through 25 under 35 U.S.C. § 102(b) as being anticipated by Burgdorf, U.S. Patent No. 4,580,847, by Shirai, U.S. Patent No. 4,812,777, or by Steiner, U.S. Patent No. 5,123,713. Claim 21 has been cancelled and Claims 23 through 25 now depend from allowed Claim 18

PARAGRAPH 7

The Examiner has rejected Claims 21 through 25, and 36 through 40 under 35 U.S.C. § 102(b) as being anticipated by Steiner, U.S. Patent No. 5,123,713. The Examiner asserts that "Steiner meets the claimed requirements as broadly claimed," and notes the operation of the valves 48, 49 and the fluid separator devices 24 and/or 26.

With respect to Claims 22 and 36 through 40, Applicants again respectfully disagree. Steiner teaches a master cylinder 18 as a source of pressurized hydraulic brake fluid, and an auxiliary pressure source 43. When the brake pedal 16 is depressed, the master cylinder 18 supplies fluid to the brakes 12 and 13. While the master cylinder 18 is supplying fluid to the brakes 12, 13, if the ABS system 11 recognizes a locking condition in either of the brakes 12, 13 that requires control, the valve 48 is switched into its blocking position and the pressure modulator 24 is blocked from the master cylinder 18. The inlet control valve 39 is switched into its blocking position and the outlet control valve is switched into its through-flow position. The control pressure chamber 37 of the pressure modulator 24 is then pressure-relieved with respect to the reservoir 47. If the locking condition subsides, the valve 39 is switched back into its through-flow position, and fluid from the auxiliary pressure source 43 can be supplied to either of the brakes 12, 13. The auxiliary pressure source 43 can only supply pressurized fluid after the master cylinder 18 has supplied pressurized fluid to the brakes 12, 13 and the ABS system 11 has been activated. Therefore, the master cylinder 18 is the normal source of pressurized hydraulic fluid. Steiner also teaches that the master cylinder 18 (the normal source) is the only source of pressurized fluid in the event of electrical failure in the brake system. There is no other (backup) source of pressurized fluid to the brakes in such an event.

Claims 22 and 37 through 40 recite a normal source and a master cylinder for carrying out a backup brake operation. Claim 36 recites a normal source and a backup source comprising a master cylinder. The Specification at column 23, lines 57 through 65, describes the operation of the normal source and the backup source as follows, "as

in the previous embodiments of the brake system 2, 200 and 300, upon failure of the normal source of pressurized hydraulic brake fluid 4 to the vehicle brakes 11a and 11b, or upon failure of the control module, the backup source 6 of pressurized hydraulic brake fluid supplied by the master cylinder 12 will be an available source of pressurized hydraulic brake fluid to be applied to the brakes of the brake system 350."

Steiner teaches that the master cylinder 18 is the normal source of pressurized fluid. Steiner also teaches that the master cylinder 18 is the only source of pressurized fluid in the event of electrical failure in the brake system. The auxiliary pressure source 43 is not a backup source of pressurized hydraulic fluid, as defined in Applicants' Specification and described above, since, for example, it cannot supply pressurized fluid to the brakes in the event of an electrical failure, because it cannot position the electrical solenoid valves to do so. Steiner does not teach a backup source of pressurized fluid that is applied to the brakes 12, 13 separate from the normal source of pressurized fluid.

The master cylinder of Steiner cannot be considered both a normal source of pressure (as taught by Steiner) and a backup source of pressurized fluid (as suggested by the Examiner), to meet the limitations recited in Claims 22 and 36 through 40. Applicants again respectfully request reconsideration of the rejection of record.

PARAGRAPH 8

The Examiner rejected Claims 36 through 40 under 35 U.S.C. § 102 as being anticipated by Weiner et al., U.S. Patent No. 5,588,718.

Each of Claims 36 through 40 include the above-referenced respective "substitute limitations" for the asserted "key limitations" of a fluid separator and movable pressure boundary. The Examiner noted that Winner et al. lacked a showing of a fluid separator. Therefore, it is believed that Claims 36 through 40 are not anticipated by Winner et al. and Applicants respectfully request reconsideration of the rejection of record.

PARAGRAPH 11

The Examiner rejected Claim 37 under 35 U.S.C. § 103 as being unpatentable over Winner et al., U.S. Patent No. 5,588,718, in view of Steiner, U.S. Patent No. 5,123,713. The Examiner asserts that it would have been obvious to provide the device of Winner et al. with fluid separator units as taught by Steiner to adjust the pressure output to the wheel brakes. Applicants respectfully disagree. There is no teaching contained in any of the references that supports the combination proposed by the Examiner. Neither reference includes any teaching regarding incorporating the fluid separator as taught in Steiner in the brake system of Winner et al. Further, if the Steiner and Winner et al. reference can be combined, several resulting combinations are possible.

CONCLUSION

It is believed that Claims 1 through 46 are in condition for allowance. The accompanying copy of the previously supplied Statement Under 37 C.F.R. § 3.73(b), signed by the Assistant Secretary of the assignee indicates that the Assistant Secretary is authorized to act on behalf of the assignee. Return of the original copy of the patent will be occur when Applicants' attorney is notified that all claims are allowed, and no other issues remain to be resolved.

STATEMENT UNDER 37 CFR 3.73(b)Applicant/Patent Owner: Gregory P. Campau, et al.Application No./Patent No.: 5,941,608Filed/Issue Date: August 24, 1999

Entitled:

ELECTRONIC BRAKE MANAGEMENT SYSTEM WITH MANUAL FAIL SAFEKelsey-Hayes Company, a Corporation

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.
The extent (by, percentage) of its ownership interest is _____ %

in the patent application/patent identified above by virtue of either:

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

- B. ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: Mark S. Luckevich To: Kelsey-Hayes Company
The document was recorded in the United States Patent and Trademark Office at
Reel 8983, Frame 0590, or for which a copy thereof is attached.
2. From: Gregory P. Campau To: Kelsey-Hayes Company
The document was recorded in the United States Patent and Trademark Office at
Reel 8983, Frame 0602, or for which a copy thereof is attached.
3. From: Thomas Weigert To: Kelsey-Hayes Company
The document was recorded in the United States Patent and Trademark Office at
Reel 8983, Frame 0938, or for which a copy thereof is attached.

☒ Additional documents in the chain of title are listed on a supplemental sheet.☒ Copies of assignments or other documents in the chain of title are attached.

NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

9.3.03

Date

1-734-266-2663

Telephone number

Mariann McNally

Typed or printed name

Mariann McNally

Signature

Assistant Secretary

Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETE D FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)
Greg Campau et al.)
Patent No.: 5,941,608) Group Art Unit 3683
Issue Date: August 24, 1999) Examiner: Christopher P. Schwartz
For: ELECTRONIC BRAKE)
MANAGEMENT SYSTEM WITH)
MANUAL FAIL-SAFE) Attorney Docket 1-23339

STATEMENT UNDER 37 CFR 3.73(b)

Section B - Additional Documents in the Chain of Title

A chain of title, continued from the chain of title listed in the attached Statement Under 37 C.F.R. 3.73(b), from the inventor(s), of the patent identified above, to the current assignee as shown below:

4. From: Blaise J. Ganzel To: Kelsey-Hayes Company
The document was recorded in the United States Patent and Trademark Office at
Reel 9169, Frame 0175.

5. From: Salvatore Oliveri, Robert L. Ferger, and Andrew W. Kingston To: Kelsey-Hayes Company
The document was recorded in the United States Patent and Trademark Office at
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